EXHIBIT A

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Raymond J. Prince
Senior Technical Consultant, Technical Services Group
Graphic Arts Technical Foundation

Raymond J. Prince is a senior technical consultant in the Technical Services Group at the Graphic Arts Technical Foundation (GATF) in Pittsburgh, Pa.

A 38 year industry veteran, Mr. Prince conducts Technical Plant Assessments (TPAs) in response to technical inquiries from GATF members and industry. GATF's TPA program offers in-plant analysis of a printer's production facility and capabilities. To date, Mr. Prince has completed 730 TPAs.

As a printing specialist and troubleshooter, Mr. Prince represents technical seminars, in-plant training programs, and contributes technical information to GATF textbooks and Technical Services Reports. Additionally, he provides technical problem-solving articles called "How I See It" for *GATFWorld*, GATF's bimonthly magazine.

Mr. Prince has also co-written the GATF texts, *Solving Sheetfed Offset Press Problems* and *Solving Web Offset Press Problems*, and was the author of *Testing the Accuracy of the Step-and-Repeat Machine*, a GATF Technical Services Report.

As a lecturer and trainer, Mr. Prince teaches the following GATF seminars: "Troubleshooting in Your Printing Plant," "Paper and Ink Problems," "100+ Ideas on Producing Consistent Quality," "Solving Paper and Ink Problems in the Pressroom," "Error Prevention," "How to O.K. Color on Press," "Overcoming the Top 20 Pressroom Problems," "Slashing Make-ready," "The Future of Printing," and "Creating a Trouble-Free Prepress Department." He also presents "Color for the Production Pressroom," "Lithographic Relationships and Variable," and "Lithographic Troubleshooting" at the Rochester Institute of Technology. He has presented over 390 lectures.

Mr. Prince is a member of the Board of Directors of the National Scholarship Trust Fund (NSTF) and chairs their Marketing/Fund-Raising Committee. In 1991 he was named president of the Technical Association of the Graphic Arts (TAGA). Prior to that he served at TAGA's executive vice president. Prince has also contributed four technical papers to TAGA Proceedings, an annual compendium of scholarly technical papers. In 1996 TAGA named a graduate fellowship in his honor.

In 1992 the National Association of Printers and Lithographers named Mr. Prince Craftsman of the Year. In 1994 he received GATF's Industry Education Award, and he also achieved the Certified Quality Systems Lead Auditor Status from the Registrar Accreditation Board (RAB) of the American Society for Quality Control.

He had been a GATF technical consultant for fourteen years before he assumed the post of senior technical consultant in 1992. He previously served GATF from 1966 through 1970 as administrative and technical specialist in the Special Programs Department, where he coordinated continuing education programs, seminars, workshops, and conferences.

Upon leaving GATF in 1970 Mr. Prince joined Azoplate, a division of American Hoechst Corporation, as an application manager directing the design, development, and manufacture of graphic arts equipment. He also determined if cost and quality requirements for company products were met.

In addition to a B.S. in printing management from the Rochester Institute of Technology, Mr. Prince has an M.S. in printing management form South Dakota State University.

EXHIBIT
A

W013080

EXHIBIT B

GATFWorld Articles by Raymond J. Prince

"Streaking." January/February 1989. Page 10.
"Monday Morning Color Systems Calibration." January/February 1989. Page 10.
"Press Settings." March/April 1989. Page 12.
"Counter Etching of Plates." March/April 1989. Page 12.
"High-Quality One-Color Production." May/June 1989. Page 32.
"Test Methods and Considerations for Mechanical Ghosting in Lithography." July/August 1989. Pages 19-23.
"Contacting." September/October 1989. Page 24.

"Process Control for the Small Plant." January/February 1990. Page 22.
"Roller Durometer." March/April 1990. Page 18.
"Opaquing: Base or Emulsion Side?" March/April 1990. Page 18.
"Dot Gain." May/June 1990. Page 20.
"Ink and Dampening Solution Compatibility." July/August 1990. Page 17.
"Controlling Density during the Run." July/August 1990. Page 17.
"Film Fit." July/August 1990. Page 17.
"Show Your ID Please." September/October 1990. Page 13.
"Picking Hickeys." September/October 1990. Page 13.
"Dust in the Prepress Areas." November/December 1990. Page 15.
"Power Struggle." November/December 1990. Page 15.

"How to Gauge Image Fit on Press." January/February 1991. Page 23.
"Smoothing a Solid." January/February 1991. Page 23.
"Varnish: Fit, Drying and Ghosting." March/April 1991. Page 18.
"Blanket Tips." March/April 1991. Page 18.
"Factors in Matching Press Sheets to Proofs." May/June 1991. Page 19.
"Color Perception." May/June 1991. Page 19.
"Gear Streaks." May/June 1991. Page 19.
"Ink Trapping." July/August 1991. Page 33.
"Controlling Dot Size on Press." September/October 1991. Page 31.

"Preparing for a Press Test." January/February 1992. Page 36.
"Image Fit and Register on a Sheetfed Multicolor Press." March/April 1992. Pages 29-32.
"Contacting High-Quality Separations." March/April 1992. Page 36.
"Building Latitude into the Pressrun." May/June 1992. Page 35.
"Extending Life of Dampening Solution." May/June 1992. Page 35.
"Can My Prepress Proof Match the Press Sheet?" July/August 1992. Page 37.
"Film Contacting Fit Problems." July/August 1992. Page 37.
"When to Use One-Piece Final Composite Film." September/October 1992. Page 35.
"Lithographic Ink Waste." November/December 1992. Page 41.

"Densitometry-Proper Use, Common Errors and Misuses." January/February 1993. Page 21.
"Hickeys-Part 1." March/April 1993. Page 37.
"Hickeys-Part 2." May/June 1993. Page 39.
"Thoughts on Color Bars." July/August 1993. Page 13.
"Stochastic Screening." September/October 1993. Pages 31-32.
"The Fear of ISO 9000 for Small Companies." November/December 1993. Page 27.
"Simple Solution for a Complex Problem." November/December 1993. Page 27.

"Extending and Regenerating Fountain Solution." November/December 1994. Page 20.
"Control of Dot Gain is Getting Worse." November/December 1994. Page 20.

"To Get Quality in the Pressroom, you Have to Define It." March/April 1995. Page 5.
"Successful Customer Color Oks." May/June 1995. Page 14.
"The Importance of Dry and Wet Solid Print Evaluation." July/August 1995. Page 14.
"Image Fit--An Update on the Mechanical Perspective." November/December 1995. Page 14.

"Troubleshooting Tips for Printers and Suppliers." January/February 1996. Page 10.
"How Closely Can You Match a PANTONE Color?" March/April 1996. Page 6.
"How to Print a "Bad" Paper." May/June 1996. Page 9.
"Trends in Sheetfed Presses." July/August 1996. Page 6.
"Testing a Press for Fit." September/October 1996. Page 5.
"Proofing--The Changing Definition." November/December 1996. Page 8-9.

Books (Contributing Author, Raymond J. Prince):

Solving Web Offset Press Problems, Published by GATF
Solving Sheetfed Offset Press Problems, Published by GATF

EXHIBIT C

PRINCE EXHIBIT C

Claims of Serial No. 08/435,798
Filed May 4, 1995 - Pending as of Summer 2000

1. In a printing press of the type having side frame members forming a printing unit tower on which a plate cylinder and blanket cylinder are support for rotation, the improvement comprising:

inking/coating apparatus for applying ink or coating material directly to a plate mounted on the plate cylinder or directly to a blanket mounted on the blanket cylinder when the inking/coating apparatus is in an operative position; and

a carriage assembly including a support arm having a first end portion pivotally mounted to the printing unit tower and a second end portion pivotally mounted to the inking/coating apparatus, the carriage assembly being movable to an operative position in which the inking/coating apparatus is suspended laterally adjacent to the plate and blanket cylinders, and being movable to a retractable position in which the inking/coating apparatus is elevated with respect to the plate and blanket cylinders.

2. The invention as set forth in claim 1, wherein the inking/coating apparatus comprises:

a doctor blade assembly having a reservoir for receiving ink or liquid coating material;

an applicator roller coupled to the doctor blade assembly in fluid communication with the reservoir, the applicator roller being engagable with a printing plate on the plate cylinder of with a blanket on the blanket cylinder when the inking/coating apparatus is in the operative position.

3. The invention as set forth in claim 2, the applicator roller comprising:

an anilox roller having a resilient transfer surface.

4. The invention as set forth in claim 1, including a counterweight coupled to the support arm.

5. The invention as set forth in claim 1, further comprising:

a power actuator pivotally coupled to the support arm, the power actuator having a power transfer arm which is extendable and retractable; and,

apparatus coupled to the power transfer arm for converting extension or retraction movement of the power transfer arm into pivotal movement of the inking/coating apparatus relative to the support arm.

6. In a printing press of the type having side frame members forming a printing unit tower on which a plate cylinder and blanket cylinder are support for rotation, the improvement comprising:

inking/coating apparatus for applying ink or coating material to a plate mounted on the plate cylinder or to a blanket mounted to a blanket cylinder when the inking/coating apparatus is in an operative position;

a carriage assembly including a support arm having a first end portion pivotally mounted to the printing unit tower and a second end portion pivotally mounted to the inking/coating apparatus, the carriage assembly being movable to an operative position in which the inking/coating apparatus is suspended laterally adjacent to the plate and blanket cylinders, and being movable to a retractable position in which the inking/coating apparatus is elevated with respect to the plate and blanket cylinders;

a power actuator pivotally coupled to the support arm, the power actuator having a power transfer arm which is extendable and retractable;

apparatus coupled to the power transfer arm for converting extension or retraction movement of the power transfer arm into pivotal movement of the inking/coating apparatus relative to the support arm;

the movement converting apparatus;

a bell crank plate having a first end portion coupled to the power transfer arm and having a second end portion for engaging a stop member;

a stop member secured to the inking/coating apparatus; and

a cleavis plate secured to the support arm and pivotally coupled to the bell crank plate.

7. The invention as set forth in claim 1, the inking/coating apparatus comprising:

an applicator head having first and second side frame members pivotally coupled to the carriage assembly;

a doctor blade assembly mounted between the first and second side frame members, the doctor blade assembly including a reservoir for receiving ink or liquid coating material;

cradle means mounted on the first and second side frame members, respectively;

an applicator roller mounted for rotation on the cradle means and coupled to the doctor blade assembly for rolling contact with ink or coating material in the reservoir, the applicator roller being engagable with a printing plate on the plate cylinder or with a blanket cylinder in the operative position; and

motor means coupled to the applicator roller for rotating the applicator roller.

8. The invention as set forth in claim 7,

the cradle means including first and second sockets disposed on the first and second side frame members respectively; and,

the applicator roller being mounted for rotation on the first and second sockets.

9. In a printing press of the type having side frame members forming a printing unit tower on which a plate cylinder and blanket cylinder are supported for rotation, the improvement comprising

inking/coating apparatus for applying ink or coating material to a plate mounted on the plate cylinder or to a blanket cylinder mounted on the blanket cylinder when the inking/coating apparatus is in an operative position;

a carriage assembly including a support arm having a first end portion pivotally mounted to the printing unit tower and a second end portion pivotally mounted to the inking/coating apparatus, the carriage assembly being movable to an operative position in which the inking/coating apparatus is suspended laterally adjacent to the plate and blanket cylinders, and being movable to a retractable position in which the inking/coating apparatus is elevated with respect to the plate and blanket cylinders;

the inking/coating apparatus comprising:

an applicator heading first and second side frame members pivotally coupled to the carriage assembly;

a doctor blade assembly mounted between the first and second side frame members, the doctor blade assembly including a reservoir for receiving ink or liquid coating material;

cradle means mounted on the first and second side frame members, respectively;

an applicator roller mounted for rotation on the cradle means and coupled to the doctor blade assembly for rolling contact with the ink or coating material in the reservoir, the applicator roller being engagable with a printing plate on the plate cylinder or with a blanket on the blanket cylinder in the operative position; and

motor means coupled to the applicator roller for rotating the applicator roller;

the cradle means including first and second sockets disposed on the first and second side frame members, respectively, and third and fourth sockets disposed on the first and second side frame members respectively;

the applicator roller being mountable for rotation on the first and second sockets for applying ink or coating material to the plate when the carriage assembly is in the operative position; and

the applicator roller being mountable for rotation on the third and fourth sockets for applying ink or coating material to the blanket when the carriage assembly is in the operative position.

10. The invention as set forth in claim 1, comprising:

male and female latch coupling members mounted on the carriage assembly and on the printing unit tower, respectively, for releasably latching the carriage assembly in interlocking engagement with the printing unit tower in the operative position.

11. The invention as set forth in claim 1, wherein the support arm comprises an elongated shank portion and a hub portion which extends transversely with respect to the shank portion, the elongated shank portion being pivotally coupled to the inking/coating apparatus and the hub portion being pivotally coupled to the printing unit tower.

12. A sheet fed, rotary offset printing press comprising, in combination:

at least one printing unit or dedicated coating unit having side frame members forming a tower;

at least one cylinder mounted for rotation on the tower for printing ink or coating material onto sheets passing through the printing unit or dedicated coating unit, the cylinder mounting either a plate or a blanket;

inking/coating apparatus including a doctor blade assembly having a reservoir for holding ink or coating liquid, a rotatable applicator roller and means for applying ink or coating liquid from the reservoir onto a peripheral surface portion of the applicator roller; and

support apparatus mounted on the tower for pivotal movement, the inking/coating apparatus pivotally mounted to the support apparatus, the support apparatus movable relative the printing unit tower between an operative position in which the applicator roller is directly engaged with a plate or blanket on the cylinder and a retracted position in which the inking/coating apparatus is support at an elevated position above the cylinder.

13. A rotary offset printing press comprising, in combination:

a plate cylinder having a printing plate mounted thereon;

a blanket cylinder having an ink receptive blanket disposed in ink transfer engagement with the plate cylinder for transferring ink from the image surface areas of the printing plate to the receptive blanket;

an impression cylinder disposed adjacent the blanket cylinder thereby defining a nip between the impression cylinder and the blanket whereby the printing ink is transferred from the blanket to a substrate as the substrate is transferred through the nip;

inking/coating apparatus for applying ink or coating material to the plate or to the blanket;

support apparatus pivotally mounted on the printing press, said support apparatus and said inking/coating apparatus being pivotally connected, said support apparatus being pivotal between an operative position in which the inking/coating apparatus is directly engaged with the

plate or the blanket, and a retracted position in which the inking/coating apparatus is supported at an elevated position above the press; and

a dryer mounted on the press for discharging heated air on the freshly printed substrate.

14. A rotary offset printing press as defined in claim 13, wherein:

the dryer is mounted adjacent the impression cylinder for discharging heated air onto a freshly printed substrate while the substrate is in contact with the impression cylinder.

15. A rotary offset printing press as defined in claim 13, comprising:

an extractor coupled to the dryer for extracting hot air, moisture and volatiles from an exposure zone between the dryer and the freshly printed substrate.

16. A rotary offset printing press as defined in claim 13, comprising:

a transfer cylinder disposed in an interstation position on the press and coupled in sheet transfer relation with the impression cylinder; and,

an interstation dryer disposed adjacent the transfer cylinder for discharging heated air onto a freshly printed or coated substrate after it has been transferred from the impression cylinder and while it is in contact with the intermediate transfer cylinder.

17. In a printing press of the type having side frame members forming a tower on which a blanket cylinder is supported for rotation, the improvement comprising:

inking/coating apparatus for applying ink or coating material to a blanket mounted on the blanket cylinder when the inking/coating apparatus is in an operative position; and

a carriage assembly pivotally mounted to the tower and to the inking/coating apparatus, said carriage assembly movable between an operative position and a retracted position, said inking/coating apparatus pivoting relative the carriage assembly as the carriage assembly is

moved between the operative position and retracted position to maintain a relatively constant orientation to the horizontal, the inking/coating apparatus in direct contact with the blanket cylinder in the operative position and elevated with respect to the blanket cylinder in the retracted position.

18. In a printing press of the type having side frame members forming a tower on which a blanket cylinder is supported for rotation, the improvement comprising:

inking/coating apparatus for applying ink or coating material to a blanket mounted on the blanket cylinder when the inking/coating apparatus is in an operative position;

a carriage assembly pivotally mounted to the tower and to the inking/coating apparatus, said carriage assembly movable between an operative position and a retracted position, said inking/coating apparatus pivoting relative the carriage assembly as the carriage assembly is moved between the operative position and retracted position to maintain a relatively constant orientation to the horizontal;

tower including a plate cylinder and a plate mounted on the plate cylinder, the inking/coating apparatus including:

first cradle means for supporting an applicator roller for engagement against the plate when the inking/coating apparatus is in the operative position; and

second cradle means for supporting an applicator roller for engagement against the blanket when the inking/coating apparatus is in the operative position.

19. In a printing press of the type having side frame members forming a tower on which a blanket cylinder is supported for rotation, the improvement comprising:

inking/coating apparatus for applying ink or coating material to a blanket mounted on the blanket cylinder when the inking/coating apparatus is in an operative position;

a carriage assembly pivotally mounted to the tower and to the inking/coating apparatus, said carriage assembly movable between an operative position and an retracted position, said inking/coating apparatus pivoting relative the carriage.

20. The invention as set forth in claim 17, further comprising:

a power actuator pivotally coupled to the support arm, the power actuator having a power transfer arm which is extendable and retractable; and,

apparatus coupled to the power transfer arm for converting extension or retraction movement of the power transfer arm into pivotal movement of the inking/coating apparatus relative to the common pivot shaft.

21. In a printing press of the type having side frame members forming a tower on which a blanket cylinder is supported for rotation, the improvement comprising:

inking/coating apparatus for applying ink or coating material to a blanket mounted on the blanket cylinder when the inking/coating apparatus is in an operative position;

a carriage assembly pivotally mounted to the tower and to the inking/coating apparatus, said carriage assembly movable between an operative position and a retracted position, said inking/coating apparatus pivoting relative the carriage assembly as the carriage assembly is moved between the operative position and retracted position to maintain a relatively constant orientation to the horizontal;

a power actuator pivotally coupled to the support arm, the power actuator having a power transfer arm which is extendable and retractable;

apparatus coupled to the power transfer arm for converting extension or retraction movement of the power transfer arm into pivotal movement of the inking/coating apparatus relative to the common pivot shaft;

the movement converting apparatus comprising:

a bell crank plate having a first end portion coupled to the power transfer arm and having a second end portion for engaging a stop member;

a stop member secured to the inking/coating apparatus; and,

a cleavis plate secured to the support arm and pivotally coupled to the bell crank plate.

22. The invention as set forth in claim 1, wherein the inking/coating apparatus comprises:

an applicator roller having a resilient transfer surface.

23. The invention as set forth in claim 1, wherein the applicator roller is mounted for engagement to a plate in the plate cylinder position, the applicator roller comprising an anilox roller having a resilient transfer surface.

8

PRAVEL

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF TEXAS
DALLAS DIVISION

PRINTING RESEARCH, INC., HOWARD W. DEMOORE and, RONALD RENDLEMAN,	§	
Plaintiffs,	§	
v.	§	**CIVIL ACTION NO. 3-99CV1154-M**
WILLIAMSON PRINTING CORPORATION, BILL L. DAVIS and JESSE S. WILLIAMSON,	§	
Defendants.	§	

RESPONSIVE EXPERT WITNESS
REPORT OF BERNARR ROE PRAVEL

1. I make this report based upon my knowledge or information as to the factual matters set forth below and upon my opinions as they relate to the facts of this case. If called as a witness in this case, I expect to testify as follows:

2. I incorporate by reference my *curriculum vitae*, publications, and exhibits submitted with my report of October 5, 2000. I also incorporate by reference each of paragraphs 2-9 of said prior Expert Witness Report. I have reviewed the following additional documents since the execution of my previous report:

1. List of declarations and declarations filed in Ser. No. 09/315,796 (W012914 - W013387)

2. File wrapper of U.S. Patent No. 5,960,713 (W02035 - W02704)

3. File wrapper of U.S. Patent No. 6,082,257 (W012250 - W012557)

4. File wrapper of Serial No. 08/435,798 (W01348 - W02034)

3. It is hornbook law that "conception"of an inventor is the "formation in the mind of the inventor, of a definite and permanent idea of the complete and operative invention, as it is hereafter to be applied in practice." 1 Robinson on Patents 532 (1890). As stated by the U.S. Court of Appeals for the Federal Circuit: "All that remains to be accomplished, in order to perfect the instrument or the act or instrument, belongs to the department of construction, not invention. It is therefore the formation, in the mind of the inventor of *a definite and permanent idea of the complete and operative invention as it is thereafter to be applied in practice,* that constitutes an available conception, within the patent law." *Coleman v. Dines*, 754 F.2d 353, 359, 224 USPQ 857 (Fed. Cir. 1985) (emphasis the Federal Circuit), quoting *Gunter v. Stream*, 573 F.2d 77, 80, 197 USPQ 482, 484 (CCPA 1978). Conception exists when a definite and permanent idea of an operative invention, including every feature of the subject matter sought to be patented, is known. *Sewell v. Walters*, 21 F.3d 411, 415, 30 USPQ2d 1356 (Fed. Cir. 1994). Conception is complete when one of ordinary skill in the art could construct the apparatus without unduly extensive research or experimentation. *Id.* I have read the report of expert Jim Taylor who indicates that as of mid-June, 1994, and indeed as far back as early June 1992, Davis and Williamson were in possession of a complete concept of their claimed method of the '363 patent. Note paragraph 47, Expert Report of Jim Taylor, answers to questions (b), (e) and (f). Specifically, Mr. Taylor states that based on the information transmitted from Jesse Williamson and Bill Davis to PRI employee Baker on June 12, 1994, that one of ordinary skill in the art

> "could have readily constructed a retractable printer/coater with an anilox roller and chambered doctor for interstation use in the summer or fall of 1994 without undue experimentation, and that the

> information given to Baker was sufficient to instruct the average person skilled in the art what to do to arrive at a device to perform the flexographic/lithographic process of the '363 patent."

From the expert conclusions of Jim Taylor, I conclude that Williamson and Davis had transmitted a complete conception of their claimed invention as early as June 1994, and had in their possession a conception of the invention of the '363 patent as of that time.

4. Further, I have read the Declaration of Harry Bowyer executed September 9, 2000 bearing production numbers W013287-13311. Mr. Bowyer states that he visited Dallas in October 1992 and that Davis and Williamson, at that time, went over with him their concept of going "up front" with an anilox flexographic printer/coater and mentioned that same could be accomplished by a dedicated station, an auxiliary "rack-back" device, or a "T-head" device. Paragraph 4, Bowyer Declaration. Based upon that sworn testimony, it is clear that Williamson and Davis had a corroborated complete conception of their invention in October of 1992. According to the testimony of Davis and Williamson, they arrived at a complete concept of a workable invention, including the formation of several alternative types of devices to perform their method, when Williamson returned to the United States from Germany at the end of May 1992 or early June 1992. See Joint Declaration (1) Under 37 C.F.R. §1.131 and (2) Pertaining to Derivation by DeMoore and Printing Research, Inc. of Reissue Applicants' Invention, executed by Davis and Williamson on June 3, 2000, specifically at paragraph 4 (W012997, W012998) and Declaration of Jesse Speight Williamson, executed September 22, 2000, at paragraph 8 (W013263 at W013265). Oral testimony may be used to corroborate the testimony of an inventor for priority purposes, so long as it is appropriately scrutinized. *Jardine v. Long*, 19 CCPA 1243, 58 F.2d 836, 837, 13 USPQ 254(CCPA 1932). The communication by Davis and Williamson to Harry Bowyer constituted a corroborated

conception of the '363 invention as of the date of the discussions with Bowyer in the United States.

5. Based on the Declarations of Baker and Brown concerning their communications with Davis and Williamson in the summer of 1994, I conclude that Davis' and Williamson's conception was corroborated by those 1994 communications. Declaration of Stephen Baker executed November 3, 1999 at paragraphs 4-9 (W013251 at W013254); Supplemental Declaration of Stephen Baker executed October 5, 2000, at paragraph 2 (W013256 at W013257); and, Declaration of Scott Brown executed December 30, 1999, at paragraph 2 (W013329 at W013330.)

6. According to the Rule 131 declaration mentioned in paragraph 4, and the testimony of each of Davis and Williamson in their respective depositions, Davis and Williamson had a discussion with Baker of PRI on **June 12, 1994** in which they asked Baker of PRI to consider constructing a retractable device for WPC to perform the Davis/Williamson method. An inventor "may use the services, and aid of others in the process of perfecting his invention without losing his right to a patent." *Shatterproof Glass Corporation v. Libby-Owens Ford Company*, 758 F.2d 613, 624, 225 USPQ 634 (Fed. Cir. 1985) citing *Hobbs v. U.S. Atomic Energy Commission*, 451 F.2d 849, 864, 171 USPQ 713 (5th Cir. 1971); see also, *Hess v. Advance Cardiovascular Systems, Inc.*, 106 F.3d 976, 980-981, 41 USPQ2d 1782, 1786 (Fed. Cir. 1997). Furthermore, Fig. 2 of the '363 patent, according to the expert report of Jim Taylor, was within the method concept of Davis and Williamson. See paragraph 47, Expert Report of Taylor. Williamson and Davis hired PRI to make an auxiliary, retractable interstation coater with an anilox roller and chambered doctor. Under the applicable law, Davis and Williamson had the right to have a vendor or contractor at arms length perform the construction of a device for use with their inventive method to reduce the invention to practice. Based on one of the landmark patent cases of the United States Supreme Court, an inventor

may hire another to construct a device to perform his invention, and such hiring does not operate to create a joint invention because the intellectual property rights of the contractor belong to the true inventor. See *Agawam Company v. Jordan*, 74 U.S. (7 Wall.) 583, 19 L. Ed. 177(1868). Under the *Agawam* case, the cantilevered device technology, whether or not patentable, becomes the property of Davis and Williamson. According to expert Taylor, there were at least seven known techniques in 1994 of accomplishing the concept of the Davis and Williamson method. Nuances in the construction of an apparatus to perform the Davis/Williamson process do not change inventorship of the method or ownership rights with respect to the apparatus:

> ". . . such suggested improvements are in general to be regarded as the property of the party who discovered the original principle, and may be embodied in his patent as part of his invention."

Agawam, 19 L. Ed at 182. See also, *Amax Fly Ash Corporation v. United States*, 206 Ct. Cl. 756, 514 F.2d 1041, 1050, 182 USPQ 210, 185 USPQ 437 (Ct. Cl. 1975); *Mueller Brass Co. v. Reade Industries*, 352 F.Supp. 1357, 1374, 176 USPQ 361 (E.D.P.A. 1972); *Rodgard Corporation v. Miner*, 914 F.Supp. 907, 917-918 (W.D. N.Y. 1995).

7. I have noticed in several of the depositions (specifically those of Davis and Williamson), questions on the part of counsel Harris as to the reasons why Davis and Williamson did not file a patent application until August of 1995. Davis and Williamson, having conceived their method in June of 1992, were under no duty to file a patent application or even reduce their method to practice on a hurried basis. They had not published their invention and, therefore, were not under the constraints of a 35 U.S.C. §102(b) bar. As a general rule, absent the running of the grace period after sale or publication of the invention, an inventor has no duty to file a patent application. *Bates*

v. Coe, 98 U.S. (8 Otto) 31, 46, 25 L.Ed. 68 (1878). Even in priority contests and after reduction to practice, delay in filing a patent application does not constitute an abandonment unless circumstances exist creating an inference of an intent to permanently abandon, suppress or conceal. I am not aware of any evidence of an intent to abandon their invention indicated in Davis' and Williamson's declarations or their testimony in their depositions.[1] Hence, there could be no issue of abandonment of their invention due to their alleged "delay" in filing a patent application until August of 1995.

8. In reviewing both the Complaint filed May 20, 1999 and the First Amended Original Complaint filed on September 11, 2000, there are allegations on the part of Plaintiffs that Defendants derived their claimed method from PRI employees Steve Garner ("Garner") and John Bird ("Bird") in November of 1994. See paragraph 16, First Amended Original Complaint. Garner and Bird do not support such an allegation in either of their respective declarations or their deposition testimony. Neither Rendleman or DeMoore testified that they conveyed the substance of the '363 claimed methodology to Davis or Williamson or anyone in privity with Davis and Williamson at any time during 1994 or 1995. See DeMoore Depo. p.199, line 24 - p. 200, line 5. Rendleman testified he had not read the Amended Complaint. Rendleman Dep., p. 210, line 19. Derivation can be shown

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[1] Even had there been an interference with PRI based upon any hypothetical early conception of PRI, the testimony of Davis and Williamson show reduction to practice activity between the fall of 1994 and March 1995 when WPC was ordering presses, followed by experiments performed under Davis' and Williamson's directions in December 1994, and February and March 1995, and patent drafting beginning in January 1995. *Cochran v. Kresock*, 530 F.2d 385, 394, 188 USPQ 553 (CCPA 1976).

by a communication of a complete or partial concept to the party charged with derivation, with the burden of proof being on the party asserting derivation. *Hedgewick v. Akers*, 497 F.2d 905, 908, 182 USPQ 167 (CCPA 1974). I am not aware of any evidence that Davis and Williamson derived the '363 method from DeMoore and/or Rendleman. In fact, the evidence is to the contrary through the three declarations of Bird and the two declarations of Baker. Based on their testimony, Davis and Williamson communicated the method claim to Baker on Sunday, June 12, 1994 in Atlanta, Georgia. John Bird received that information from Baker, and then Bird alone or Bird and Baker transmitted it to DeMoore on the morning of June 15, 1994.

9. Concerning Plaintiffs' claim of inventorship in DeMoore, alone (Original Complaint of May 20, 1999) or of DeMoore and Rendleman jointly (in their First Amended Original Complaint), I am not aware of adequate proof of a conception on the part of DeMoore and/or Rendleman of the '363 method in the summer or fall of 1994. A party seeking to prove conception may not rely *solely* on the oral testimony of the alleged inventor because conception is a mental act. Some form or corroborating evidence - i.e., evidence in addition to the inventor's oral testimony - is required. *Burroughs Welcome Co. v. Barr Lab, Inc.*, 40 F.3d 1223, 1228, 32 USPQ2d 1915 (Fed. Cir. 1994); *Price v. Symsek*, 988 F.2d 1187, 1194 - 1996, 31 USPQ2d 1905 (Fed. Cir. 1993). If the alleged inventor's oral testimony is not corroborated, it cannot be credited. *AMP, Inc. v. Fujitsu Mircoelectronics, Inc.*, 853 F. Supp. 808, 821-822, 31 USPQ2d 1705 (N.D. Penn. 1994). DeMoore's claim of inventorship made in his original complaint and indicated in his deposition testimony as having been transmitted to his patent attorney on or about July 7, 1994, has not been corroborated, is suspect, and subject to great scrutiny. *Gianladis v. Kass*, 51 CCPA 753, 760; 324 F.2d 322, 327-8, 139 USPQ 300 (CCPA 1963). Such allegations of corroboration when no third parties are involved

-- only employees of an adversary and their lawyer-- must be scrutinized with great particularity and care, especially six years after the event. *Schwartz v. Graeng*, 23 CCPA 883, 896; 81 F.2d 767, 776, 28 USPQ 386 (CCPA 1936). Rendleman, as an alleged co-inventor of the claimed method indicated in the First Amended Original Complaint, cannot corroborate his alleged joint method invention. The invoice of the attorney, Dennis Griggs, indicates that an "office conference" [i.e., at the office of Griggs] occurred with Howard DeMoore and John Bird on July 7, 1994. No other PRI employees are indicated as being present, contrary to Rendelman's and DeMoore's deposition testimony. Bird specifically repudiates in his supplemental declaration testimony and deposition testimony that the invention originated with DeMoore or anyone else at PRI including himself. The only remaining person at the meeting is the lawyer -- inherently suspect -- who has yet to testify. PRI executive, Garner indicated in his declaration, that he did not "recall seeing anything in writing or otherwise at PRI concerning the 'long-arm' proposed interstation device prior to December 1994 - no invention records, no memoranda, no e-mails, no notebooks, no designs, no blueprints, no advertisements and no parts." Declaration of Steve M. Garner, para. 10 (W013383, W013386). In the absence of any written records whatsoever of a conception on July 7, 1994, and unsupported by any corroborative oral testimony of Bird, and absent any corroborative testimony by any witness other than the alleged inventors, DeMoore's alleged statements to his attorney on July 7, 1994 in a meeting are insufficient and are not properly corroborated. *Schwartz, id.*

10. Beyond the meeting of July 7, 1994, DeMoore does not indicate any evidence of possible inventive activity concerning the method until drawings on the part of Rendleman in November - December 1994. A review of the contemporaneous writing portion of the November 1994 - February 1995 drawings, page by page, do not evidence a conception of the method. Several

alternative *structures* are shown at the end-of-press and some are marked as "interstation" devices, but disclosures of devices even labeled "interstation" (Note several drawings PRI 006, PRI 001143, PRI 001144) do not in and of themselves constitute a legally competent complete conception of a method invention. No indication is made on the drawings of why the artisan would want to go "up front" in a lithographic press with a retractable device. The reference to a "rubber anilox" roller on those drawings is not enabling, for the reasons below. Those drawings, at best, are only indicia that the artisan involved may have been considering an apparatus which would perform some method, not of the method itself. More importantly, the particular *method* claimed in the '363 patent is not revealed in the drawings themselves. The drawings do not tell one of ordinary skill in the art the problem to be solved, let alone the advantages of an "interstation" device to solve such a problem. The drawings do not tell the artisan "how to use" the invention, which §112, first paragraph requires. *In re Gardner*, 57 CCPA 1207, 427 F.2d 786, 789, 166 USPQ 138 (CCPA 1970). Concrete statements of utility and purpose are required for a conception or constructive reduction to practice. *Standard Oil Co. (Ind.) V. Montedison S.p.A.*, 494 F. Supp. 370, 385, 206 USPQ 676, 207 USPQ 298 (D. Del. 1980), *aff'd*, 664 F.2d 356, 212 USPQ 327 (3d Cir. 1981); *duPont v. Phillips Petroleum*, 656 F.Supp. 1343, 2 USPQ2d 1545, 1552 (D. Del. 1987), *aff'd in part, rev'd in part*, 849 F.2d 1430, 7 USPQ2d 1129 (Fed. Cir 1988).[2] The technical expert reports of both Prince and Taylor

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[2] Appreciation is part of each of the patent law's legal concepts of conception and reduction to practice. *Tilghman v. Proctor*, 102 U.S. (12 Otto) 707, 711-712 26 L.Ed. 279 (1881); *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U.S. 45, 43 S.Ct. 322, 67 L.Ed. 523 (1923); *Heard v. Burton*, 51 CCPA 1502, 333 F.2d 239, 142 USPQ 97 (CCPA 1964); *Jennings v. Hill*, 38 CCPA 701, 184 F.2d 187, 87 USPQ 93 (CCPA 1950). The invention must be described sufficiently to impart to a person with ordinary skill and knowledge of the prior art the information needed to devise the invention without further genuine inspiration or undue experimentation. *Seymour v. Osborne*, 78 US (11 Wall) 516, 29 L.Ed. 33 (1871); *In re LeGrice*, 49 CCPA 1124, 301 F.2d 929, 933-934, 133 USPQ 365 (CCPA 1962).

conclude that the drawings in the period from November 1994 to February 1995, taken alone, are not evidence of a teaching of a method. See Taylor report, ¶47, answer to question (c); Prince report, ¶8, answer to question (d).

11. DeMoore and PRI are, therefore, left with their patent application filed on May 4, 1995, Serial No. 08/435,798, as possible evidence of their conception of the '363 method and possibly a constructive reduction to practice. However, the patent application is similarly defective: it does not incorporate by reference the earlier WIMS '976 patent concerning the application of integrated metallic inks, nor any other writing which would give one of ordinary skill the motivation to go "up front" with a flexographic step. Both experts Prince and Taylor are highly critical of Serial No. 08/435,798 for that reason. Taylor report, ¶47, answer to question (d); Prince report, ¶8, answer to question (e). It is well settled that an application, for constructive reduction to practice, must disclose *specific purposes* for which the invention may be used; this requirement may be met either by including utility statements within the application or by introducing evidence that reported properties of the invention were sufficient to justify the conclusion that the material was used for specific purposes. *Standard Oil, Id.* Importantly, Serial No. 08/435,798 did not incorporate by reference the important '976 WIMS patent, which was the basis for the very process improvement of the '363 patent. The application discloses a "double bump" concept whereby the user could allegedly use "interchangeably anilox" or "resilient anilox" rollers at the plate or blanket cylinders to accomplish coating or printing. Expert Taylor indicates that such purported "interchangeability" of printing or coating at the plate or blanket cylinders was in 1995, and is today, illusory. Taylor report, ¶¶47 and 55. Furthermore, expert Taylor indicates that there is no operable support for the

term "resilient" on page 12 of Serial No. 08/435,798. *Id.* Such an opinion was shared by examiner Fisher in the first Office Action which occurred in Serial No. 08/538,422, leading to U.S. Patent No. 5,960,713, claiming the benefit of the filing date of Serial No. 08/435,798 in a "continuation-in-part" application in August 1998. In my opinion, because it did not incorporate the '976 patent or any other possible parallel teaching, Serial No. 08/435,798 failed in that aspect of 35 U.S.C. §112, first paragraph, in that it did not sufficiently disclose *how to use* the '363 claimed method invention. *Gardner, supra.* Serial No. 08/538,422 was subject to a 35 U.S.C. §112, first paragraph *final rejection,* and DeMoore chose to refile his application and insert new matter (in what became part of column 16 of the '713 patent) as a continuation-in-part, rather than to continue to traverse such a §112, first paragraph rejection and appeal the §112, first paragraph rejection to the Board of Patent Appeals and Interferences. Such a "roll-over" by continuation-in-part without appeal worked an acquiescence on the part of DeMoore; DeMoore and PRI are estopped to deny the lack of enablement of the term "resilient anilox roller." *Pennwalt v. Akzona, Inc.*, 570 F. Supp. 1097, 1101-1104 (D. Del. 1983), *aff'd* 740 F.2d 1573, 222 USPQ 833 (Fed. Cir. 1984). Simply put, for a multitude of reasons, Serial No. 08/435,798 is not enabling and is not a constructive reduction to practice.

12. I have reviewed the file history of Serial No. 08/435,798 from its filing date in May 1995 to June of this year. The application as filed has only two method claims (24 and 30), neither one of which, in my opinion, is Davis' and Williamson's method. Moreover, all of the originally filed method claims were dropped after a restriction requirement and "without traverse." This is tantamount to an intent not to claim. The fact that Davis' and Williamson's method was not claimed is important, as I believe current law dictates that claiming an invention is a requirement of a

constructive reduction to practice in priority disputes. *See, Hybritech Incorporated v. Monocloned Antibodies*, 802 F.2d 1367, 1376, 23 USPQ 81 (Fed. Cir. 1986), and cases cited therein (". . . and, it has long been the law, constructive reduction to practice occurs when a patent application on the claimed invention is filed.")

13. Though not emphasized, Plaintiffs allude to the possibility of a "joint inventorship" on the part of Plaintiffs' employees and Davis and/or Williamson with respect to the '363 patent. However, as the declaration and deposition testimony of all parties indicates, all agree that the companies were not *collaborating* toward the solution of a printing problem at any time in 1994. A joint invention is simply the product of *collaboration* between two or more persons *working [closely] together* to solve a problem commonly addressed. *Fina Oil and Chemical Company v. Ewen*, 123 F.3d 1466, 1473, 43 USPQ2d 1935 (Fed. Cir. 1997). There is no evidence whatsoever of a commonly addressed problem. Furthermore, consistent with the parties' uniform testimony, there is no evidence that the parties actually "worked together." In fact, there is no evidence that they ever corresponded with each other by memoranda or e-mails, or interacted in any matter to try to solve a common problem. Each of Davis and Williamson (Rule 131 Declaration, ¶8 (W013000), and Bird Suppl. Decl. ¶¶3-4 (W013194) testify that Davis and Williamson were instructing Bird as to the method starting in August 1994. Davis testified that the tests conducted at PRI in December 1994 and February 1995 were under his direction alone and that Williamson Printing Corporation ("WPC") provided many of the materials. Bird agreed in his deposition. The tests in February 1995 were similarly under Davis' directions and WPC again provided most, if not all, the materials. Bird agreed with that also. The tests in December 1994 and February 1995 were long after the conception transmitted to Baker on June 12, 1994 and were directed to the implementation of the Davis and

Williamson method concept at their instruction. *Agawam*. Rendleman only testified about a March 1995 trip to Williamson in order to take measurements to make the device requested by Davis and Williamson. Garner's above-recited testimony, that there were no e-mails, notebooks or memoranda between the parties in 1994, further substantiates my opinion that there cannot be a proper finding of joint inventorship.

14. As indicated above, there was no testimony whatsoever in the Rendleman and DeMoore depositions that at any time either DeMoore or Rendleman ever transmitted information concerning a conception of a method to Davis or Williamson or anyone else at WPC. Absent evidence of derivation on the part of WPC and absent joint inventorship, the remedial provisions of 35 U.S.C. §256 are simply not designed to embrace a straight priority contest initiated in the U.S. Federal Courts between two companies, which would parallel an interference proceeding conducted under the rules in the United States Patent and Trademark Office. *Rawlplug Company v. Hilti Aktiengesellschaft, et al.*, 777 F. Supp. 240, 243 (S.D. NY 1991); *Rival Manufacturing Company v. Dazey Products Company*, 358 F. Supp. 91, 101, 177 USPQ 422 (W.D. MO. 1973). *The patent statutes give the United States Patent and Trademark Office exclusive initial jurisdiction to determine priority by interferences*. 35 U.S.C. §135. Plaintiffs' Original Complaint filed May 20, 1999 and First Amended Original Complaint filed September 11, 2000 both speak in terms of *derivation on the part of WPC* of a method allegedly invented by DeMoore, trademarked as "LITHOFLEX™". However, *the proof is clearly to the contrary and is that DeMoore derived the method from Davis and Williamson in mid-June of 1994*. Both the Complaint and the Amended Complaint indicate that Bird and Garner told WPC about the '363 process. Bird and Garner testify

both in their declarations and in their depositions to the contrary. Rendleman's testimony does not support DeMoore's derivation accusation. Most importantly, DeMoore himself indicates he did not speak to Davis and Williamson.

> "Q. My question to you – did I ask you whether you had any discussions with Bill Davis or Jesse Williamson where you disclosed anything about the flexo/litho process to them?
>
> **A. Never talked to them about it.**
>
> Q. At any time?
>
> **A. Any time.**
>
> Q. Okay. And I might have already asked you that, if I had, I'm sorry.
>
> **A. That's all right."**

DeMoore Deposition, p. 199, line 24 - p. 200, line 8. The Mott report indicates that Plaintiffs want to use Ser. No. 08/435,798 as part of a priority fight. Lacking any evidence of derivation or of joint inventorship, Section 256 cannot be used as a mechanism to accomplish the priority goals of DeMoore urged in the Mott expert report.

15. As indicated above, 35 U.S.C. §256 was not intended by Congress for the adjudication of a priority contest. Priority contests are to be undertaken at the first instance only in the Patent and Trademark Office pursuant to an interference. That can occur either by declaration of an examiner, pursuant to 35 U.S.C. §135(a), or by a claim timely copied by an applicant for patent from an issued patent pursuant to 35 U.S.C. §135(b)(1):

> "A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless a claim is made prior to one year on the date

on which the patent was granted."

In the present instance, PRI and DeMoore indicate (contrary to former PRI employee and executive, Steve Garner, that he knew in December 1997), that they did not know about the issued '363 patent until December 1998, more than a year after the issuance of the patent. However, 35 U.S.C. §135(b)(1) does not indicate that the one year bar is subject to any such knowledge requirement. On the contrary, it establishes a one-year statute of limitation, *regardless* of actual knowledge of the issued patent on the part of the patent applicant. Hence, an interference or priority contest is barred by 35 U.S.C. §135(b)(1) in this situation regardless of whether Garner is telling the truth (PRI knew in December 1997) or DeMoore is telling the truth (in December 1998) in regard to when PRI actually knew about the '363 patent. 35 U.S.C. §291 is not available to PRI as Ser. No. 08/435,798 has not issued and its pending claims do not claim the same invention as the '363 patent. The case law of §291 indicates that for that section to be applicable, both parties must have "substantially identical" patents, and they must be directed to the "same invention". *Dooley Improvements v. Central Hanover Bank & Trust Co. of New York*, 1533, 41 USPQ 698, 27 F. Supp. 531 (D. Col. 1939); *Richard D. Albert, v. Kevek Corporation*, 741 F.2d 396, 399, 223 USPQ 1 (Fed. Cir. 1984); *Engler v. General Electric Co.*, 144 F.2d 191, 194, 62 USPQ 259; *International Signal Co. v. Vreeland Apparatus Co.; Inc., et al*, 278 F. 468, 470-471 (2d Cir. 1921). There is no "doctrine of equivalents" in §291 practice. Even were Ser. No. 08/435,798 to issue, there would still be no 35 U.S.C. §291 jurisdiction. What Plaintiffs have tried to do is pursue, under the guise of 35 U.S.C. §256, a belated *non-derivation* priority action barred under 35 U.S.C. §135(b)(1) for a non-'363 claimed invention, that even were Ser. No. 08/435,798 issued, could not be properly maintained under 35 U.S.C. §291.

16. Had an interference been declared on a timely basis within a year of the grant of the '363 patent (on or before May 20, 1998), it is clear that based on the present testimony of Davis and Williamson, WPC would have won the interference. They could have proved both (1) an early corroborated conception in 1992 of their claimed method invention and (2) derivation on the part of DeMoore and PRI on June 12, 1994 of their conceived and later claimed invention. *Shatterproof* and *Agawam* still would have applied. Neither party could have proved an actual reduction to practice prior to WPC's filing date and constructive reduction. Moreover, PRI's alleged constructive reduction of May 4, 1995 could not survive scrutiny. Davis and Williamson could have attacked successfully PRI's alleged "right to make" any method count(s) for lack of enablement, including failure to teach the artisan the significance of the invention so he will know "how to use" the invention.

17. In both the Original Complaint and the First Amended Original Complaint, Plaintiffs urge breach of contract (Amended Original Complaint, Count V) and misappropriation of trade secrets and breach of confidence (Amended Original Complaint, Count VI). Considering the facts here, both counts are, in my opinion, spurious. DeMoore handed out brochures of the "EZ" interstation at the DRUPA conference in May 1995 before an interstation device had been built. DeMoore and PRI published the contents of Serial No. 08/435,798 by the publication of foreign counterparts such as EP 741 025 (A3) in the fall of 1996. DeMoore thus published whatever alleged trade secrets were in the patent application when he filed his original U.S. application on May 4, 1995, since he intended to file foreign applications which was his and PRI's custom. Moreover, DeMoore and PRI did not own the subject matter of Serial No. 08/435,798 to the extent technology within the preview of Fig. 2 of the '363 patent, as that technology was within Davis' and

Williamson's concept and *were the property of WPC, having been completed because of an arms-length contract between PRI and WPC. Agawam.* In my opinion, the depositions, to date, show no implied obligations of confidentiality on the part of WPC with respect to any work performed by PRI for WPC.

18. Based on the expert witness report of Ray Prince, I understand the following: PRI not only filed a patent application directed to the retractable device made at WPC's instructions for the performance of the Davis/Williamson process, Serial No. 08/435,798 (W014527 - W014579), but filed four applications on October 2, 1995 having identical specifications (except as noted below), but not identical claims. These four applications were filed as Serial Nos. 08/538,274 (leading to U.S. Patent No. 5,598,777); 08/538,123 (leading to U.S. Patent No. 5,651,316); 08/538,422 (leading to U.S. Patent No. 5,960,713); and 08/538,021 (leading to U.S. Patent No. 6,116,158). The early 1997 issued '777 and '316 patents did not attempt to claim the benefit of the cantilevered device application, Serial No. 08/435,798. In the instance of the '713 prosecution, a "preliminary amendment" (concurrent with the filing of a "continuation-in-part" application, Serial No. 09/136,901 on August 19, 1998) claimed the benefit of Ser. No. 08/435,798, and in the instance of the '158 prosecution, at the time PRI's present attorneys took over the prosecution in August 1998.

19. In the prosecution of U.S. Patent No. 5,960,713, in the original application Serial No. 08/538,422 the first office action was on January 9, 1997, rejecting all claims, including claims 3, 25 and 26 under 35 U.S.C. §112, first paragraph (Note W02141 - W002142) as the term "anilox roller having a resilient transfer of service" in those claims was deemed by the examiner as not supported by an enabling disclosure. A 35 U.S.C. §112, first paragraph rejection was made *of the same and additional claims in the final rejection on October 28, 1997.* Rather than traverse the art

and 35 U.S.C. §112, first paragraph rejections, applicants DeMoore, et al. chose instead to file a "continuation-in-part application", inserting matter (which ended up in the '713 patent in Col. 16, lines 17-41 (W015393)) to enable the "resilient anilox roller" limitation in certain claims and also, *claim the benefit of the May 4, 1995 filing date of Serial No. 08/435,798.*

20. I have reviewed the expert report of Ray Prince and the Second Supplemental Declaration he filed in the Patent and Trademark Office whereby Prince compared technically the substance of each and every claim of the '713 patent to the specification of Serial No. 08/435,798, and Prince found that none of the claims were supported by the text of Serial No. 08/435,798. It is clear to me as a patent lawyer from an examination of the claims of the four applications filed on October 2, 1995, that none of those claims are supported by the disclosure of Serial No. 08/435,798; the May 4, 1995 application was directed to an auxiliary, cantilevered device which contacted blanket and/or plate cylinders on the *side opposite the dampener*; the four October 2, 1998 applications were directed to technology whereby one, and preferably both the plate and blanket cylinders were contacted *on the dampener side* in *dedicated* stations. The figures and the text of the two different applications were different. In my opinion, based on Ray Prince's factual examination, and my knowledge of procedures of the Patent and Trademark Office, the claims under 35 U.S.C. §120 to the filing date of Serial No. 08/435,798 in (1) the prosecution leading to the '713 patent, and (2) the prosecution leading to the '158 patent were improper. See Prince report, ¶8, answer to question (t).

21. Moreover, an examination of the continuation-in-part declaration filed in August of 1998 shows no disclosure to the Patent and Trademark Office, as is required by PTO rules and traditional PTO practice of the *published counterparts* of Serial No. 08/435,798 (such as EP 741,025

(A3)) or the published counterparts of Serial No. 08/538,422, which occurred in April of 1997, all more than a year before the filing date of Serial No. 09/136,901 leading to the '713 patent. The critical fact is that Serial No. 08/435,798 was under final rejection. *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 148, 109 S.Ct. 971, 103 L.Ed.2d 118, 9 USPQ2d 1847, 1851 (1969); *Chromalloy American Corporation v. Alloy Surfaces, Co.*, 339 F. Supp. 859, 872-876, 173 USPQ 295 (D. Del. 1972). Such failure to disclose published foreign counterparts of earlier applications in the continuation-in-part chain constitutes a violation of 37 C.F.R. §1.56(a), the "duty of disclosure" and constitutes inequitable conduct on the part of DeMoore.. *Chromalloy American Corp. v. Alloy Surface, Inc.*, 55 F.R.D. 406, 410, 175 USPQ 148 (D. Del. 1972). The similarity between the facts in this case involving the '713 patent and *Chromalloy* is striking. It is noted that DeMoore and PRI had just changed counsel in early July 1998 from Sidley & Austin to Locke, Liddell & Sapp, and PRI, DeMoore and Rendleman were in a unique position to know the existence of and the status of foreign counterparts of their pending applications at the time of transfer *and they had a duty to inform counsel of when a continuation-in-part was filed.* Further evidence of failure to comply with the duty of disclosure is seen in the failure to disclose the '363 patent until the issue fee was paid in the '713 prosecution in the spring of 1999, despite the fact that, as PRI '713 counsel admitted in the paper to the PTO, the '363 patent was known to PRI at least as early as December of 1998.

22. Similar disclosure problems exist in the prosecution of U.S. Patent No. 6,082,257 to Secor which has substantially all of its disclosure and figures coming from Serial No. 08/435,798. Applicant Secor at no time disclosed to the Patent Office the fact that the bulk of the disclosure and figures came from Serial No. 08/435,798, and did not disclose the publication of foreign counterparts

to Serial No. 08/435,798, which had been published more than a year prior to his filing date. Ironically, Secor disclosed the second published patent of the four patents commonly based on the October 2, 1995 filing date, but did not disclose the pertinent foreign publication counterparts to Serial No. 08/435,798 directed to the cantilevered device that had the "bumping" problem his device was directed to solve. Secor's application and that of Serial No. 08/435,798 were assigned to different examiners, and the file history of Serial No. 08/435,798 and the '257 patent reflects neither examiner knew about the existence of the other application. The '257 examiner should have been informed about Serial No. 08/435,798 and the fact that a different *inventive entity had allegedly invented same, as well as the foreign counterparts.* Secor also "borrowed" the same insertion pertaining to the supporting enablement for "resilient anilox roller" at Col. 16, lines 17-41 in the prosecution leading to the '713 patent on August 19, 1998. Accordingly, very little of the '257 patent specification and drawings can be possibly attributed to Secor, something that his examiner did not know.

B. R. Pravel

Bernarr R. Pravel

Date: Nov. 16, 2000

CERTIFICATE OF SERVICE

I hereby certify that the foregoing Responsive Expert Witness Report of Bernarr Roe Pravel was served on Plaintiffs' counsel by placing a true and correct copy thereof in the United States Mail, postage prepaid, on the 17 day of November, 2000, addressed as follows:

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